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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,144	03/18/2005	Carl Sidonius Maria Andela	12810-00240-US	5241

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CONNOLLY BOVE LODGE & HUTZ, LLP  
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WILMINGTON, DE 19899

EXAMINER
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HANLEY, SUSAN MARIE

ART UNIT	PAPER NUMBER
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1651

MAIL DATE	DELIVERY MODE
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11/14/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/500,144

Applicant(s)

ANDELA ET AL.

Examiner

Susan Hanley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8 and 12-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8 and 12-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

The amendment and claims filed 8/16/07 are acknowledged.

Claims 1, 2, 4-8, and 12-26 are pending.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### *Withdrawal of Objections and Rejections*

The objections and rejection not explicitly restated below are withdrawn due to Applicant's response in the amendment filed 8/16/07.

### *New Grounds of Rejection*

#### *Claim Rejections - 35 USC § 112*

Claims 1, 2, 4-8, and 12-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 has been amended to recite the phrase "wherein the polyolefin is a polyethylene, polypropylene, polybutylene and/or polybutadiene" (emphasis added). The inclusion of the word "a" implies that derivatives of the named polyolefin are claimed. This is deemed to be NEW MATTER because the scope of the claims has been widened and the specification lacks written description for the compounds included in the increased scope of the polyolefins. That is, a polyethylene is any possible substituted or modified polyethylene (e.g., a chlorinated polyethylene

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or a polyethylene having phenyl groups attached to the backbone) and the specification does not provide written description for these newly claimed derivatives.

The specification provides an adequate written description of polyethylene, polypropylene, polybutylene and polybutadiene. However, the description of the derivatives encompassed by amended claim 1 (e.g., "a polyethylene") is non-existent and no examples of such polymers are provided. The specification fails to inform the reader as to the types of structural changes and/or substituent additions that are included in the claimed polyolefin derivatives. Thus, the polymer derivatives encompassed by amended claim 1 lack descriptive basis because the specification as filed clearly does not provide a representative sample of the polymers encompassed by the claims, given the huge variation in physical, structural, and chemical properties encompassed by the current broad claim language. Because the amended claims encompass a multitude of polymers neither contemplated nor disclosed by the as-filed disclosure, it is clear that applicant was not in possession of the full scope of the claimed subject matter (e.g., derivatives of the claimed polyolefins) at the time of filing. This is a NEW MATTER rejection.

#### ***Response to Arguments***

#### ***Claim Rejections - 35 USC § 103***

Claims 1, 2, 5, 6, 8, 12-21, 25 and 26 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Itoh et al. (US 5,080,917; cited in the IDS filed 11/15/06) in view of Thoma et al. (1999).

Applicant argues that the rejection has been overcome because the claim limitations of claim 3 has been incorporated into claim 1. Applicant asserts that neither Itoh nor Thoma, alone or

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in combination, disclose the polyolefin combinations of claim 3 which was acknowledged by the Examiner.

Applicant's argument has been considered but is deemed non-persuasive. The amendment to claim 1 is of much greater scope than the limitations of claim 3. Claim 3 was drawn to a polyolefin that was polyethylene and/or polypropylene. The amendment to claim 1 recites the phrase "wherein the polyolefin is a polyethylene, polypropylene, polybutylene and/or polybutadiene" (emphasis added). The inclusion of the word "a" implies that derivatives of the named polyolefin are claimed. That is, a polyethylene is any possible substituted or modified polyethylene. Itoh discloses coatings that include alkyl esters of methacrylic acid and dimethylaminoethyl methacrylate such as Eudragit E100 (Butyl methacrylate-2-(dimethylamino)ethyl methacrylate-methyl methacrylate polymer). Alkyl esters of methacrylic acid are derivatives of polyethylene because the polyethylene backbone is substituted by a methyl group and a pendant carboxy group. Hence, the disclosure by Itoh meets the limitations of claim 1.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

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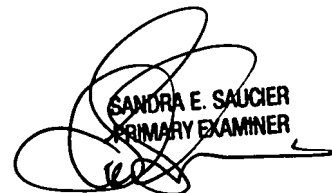
calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Hanley whose telephone number is 571-272-2508. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Susan Hanley  
Patent Examiner  
Au 1651

  
SANDRA E. SAUCIER  
PRIMARY EXAMINER